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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,322	07/18/2006	Yoshikazu Fukui	2006_0755A	3863
513 7590 01/22/2008 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021			EXAMINER LOEWE, SUN JAE Y	
			ART UNIT 1626	PAPER NUMBER
			MAIL DATE 01/22/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/581,322	Applicant(s) FUKUI ET AL.	
	Examiner Sun Jae Y. Loewe	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) 3, 11, 13, 14, 16-25 and 28-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-10 and 26 is/are rejected.
- 7) ☒ Claim(s) 12 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6-1-2006; 7-18-2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-26 and 28-30 are pending in the instant application. Claim 27 was cancelled by preliminary amendment filed on June 1, 2006.

Election/Restrictions

2. Applicant's election with traverse of Group I in the reply filed on December 3, 2007 is acknowledged. The traversal is on the ground(s):

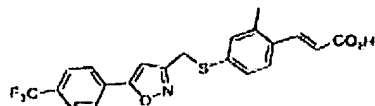
“ compound of Ruggeri is different from our compound, because their two node bridge between isoxazole and phenyl is -NH-NH- but our two node bridge is -CH₂-X1-. Therefore, the Applicant disagrees that its invention lacks unity because of Ruggeri (1924). ”

The reference of Ruggeri was mistakenly applied; it is noted that the reference does not teach the core structure shared by the instantly claimed compounds.

The restriction requirement dated November 2, 2007 stated that that the basis of restriction is the lack of novelty of the instantly claimed core structure. Notwithstanding the inapplicability of the reference of Ruggeri, it is maintained that the core structure is not novel. See Applicant's disclosure (instant specification p. 3) and discussion below, Section 9.

The restriction requirement is still deemed proper and is therefore made FINAL.

3. Applicant's election of Compound β -2-38 (below) in the reply filed on December 7, 2007 is acknowledged. Because Applicant did not distinctly and specifically point out the supposed errors in the election of species requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).



4. The guidelines below were applied for the search and examination detailed herein.

excerpts MPEP § 1893.03(d)

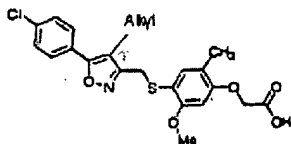
Note: the determination regarding unity of invention is made without regard to whether a group of inventions is claimed in separate claims or as alternatives within a single claim. The basic criteria for unity of invention are the same, regardless of the manner in which applicant chooses to draft a claim or claims.

>If an examiner (1) determines that the claims lack unity of invention and (2) requires election of a single invention, when all of the claims drawn to the elected invention are allowable (i.e., meet the requirements of 35 U.S.C. 101, 102, 103 and 112), the nonelected invention(s) should be considered for rejoinder. Any nonelected product claim that requires all the limitations of an allowable product claim, and any non-

¶ 18.20 *National Stage Election of Species in 35 U.S.C. 371 Applications*

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If

The elected species appeared to be allowable. Thus, the search and examination was extended to non-elected species of



to determine patentability of the generic claims encompassing Applicant's election. The species were found to be obvious over the prior art. Thus, the generic claims were rejected and non-elected species were held withdrawn from further consideration.

5. Claims 3, 11, 13, 14, 16-25 and 28-30 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected subject matter. Applicant timely traversed the restriction (election) requirement in the reply filed on December 7, 2007.

Priority

6. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

7. The information disclosure statements (dated June 1, 2006 and July 18, 2006) were filed in compliance with the provisions of 37 CFR 1.97 and 37 CFR 1.98. The statements were considered. Signed copies of form 1449 enclosed herewith.

Claim Objections

8. Claims 1, 2, 4-10, 12, 15 and 26 objected to for containing non-elected subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

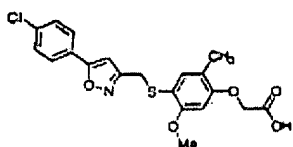
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
9. Claims 1, 2, 4-10 and 26 and 10 rejected under 35 U.S.C. 103(a) as being obvious over Filzen et al. (WO 03/084916).

Determination of the scope and contents of prior art.

The reference teaches the following compound for the same utility as instantly disclosed



(R^1 =substituted aryl; $R^2=R^3=R^4=R^5=R^8=R^9=R^{10}=R^{17}=H$; $X^1=S$; R^6 =alkyl; R^7 =alkoxy; $X^2=O$; $X^3=COOR^{17}$) – see example 41 on p. 122.

Ascertaining the differences between prior art and instant claims.

The prior art compound has been excluded from the instant claims via the proviso “compound wherein R^2 is hydrogen and X^2 is -O- are excluded.”. The following modification to the prior art reference results in compounds that are encompassed by the instant claims: alkyl substitution at the 4-position of the isoxazole ring. These modified compounds are homologs of the prior art compound taught by Filzen et al.

Resolving the level of ordinary skill in the pertinent art – Prima Facie Case of Obviousness.

To those skilled in chemical art, one homologue is not an advance over an adjacent member of a homologous series. The reason for this is that one of ordinary skill, knowing the properties of one member of series, would know what properties to expect in adjacent members. In re Henze, 85 USPQ 261 (1950). In re Wood, 199 U.S.P.Q. 137 (C.C.P.A. 1978) and In re Lohr, 137 U.S.P.Q. 548, 549 (C.C.P.A. 1963).

One of ordinary skill would be motivated, from the disclosure of Filzen et al., to make the modification required to arrive at the instant invention with reasonable expectation of success for obtaining a compound with the same activity. The motivation to make these changes would be to make additional compounds for the quoted purpose.

Thus, the instant claims are *prima facie* obvious over the teaching of the prior art.

Conclusion

10. No claims allowed.
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sun Jae Y. Loewe whose telephone number is (571) 272-9074. The examiner can normally be reached on M-F 7:30-5:00 Est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571)272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SL
1-16-2008

REBECCA ANDERSON
PRIMARY EXAMINER

Rebecca Anderson
Primary Examiner
Art Unit 1626